

REMARKS

Applicants respectfully acknowledge receipt of the Office Action mailed January 11, 2005.

By this amendment, Applicants amend the specification to update the status of an application and claim 41. Thus, claims 39-41 are pending. Of these claims, claim 39 is independent.

In the Office Action, the Examiner (1) objected to the specification; (2) rejected claim 41 under 35 U.S.C. §112, second paragraph as being indefinite; (3) rejected claim 39 under 35 U.S.C. §102(b) as being anticipated by *Nankai et al.* (U.S. Patent No. 5,266,179); and (4) rejected claims 39-41 under 35 U.S.C. §103(a) as being unpatentable over *White et al.* (U.S. Patent No. 5,438,271) in view of *Castellano et al.* (U.S. Patent No. 5,925,021).

Based on the foregoing amendments and the following remarks, Applicants traverse each of the above objections and rejections.

I. OBJECTION OF THE SPECIFICATION

The disclosure is objected to because of an informality. Specifically, the Examiner asserts that "the phrase 'now U.S. Patent No. 6,743,635, issued on June 1, 2005' should be inserted after the phrase 'U.S. Application Serial No. 10/286,648, filed November 1, 2002,' in order to update the status of this application."

Accordingly, Applicants have amended the section entitled "Cross-Reference to Related Applications" in order to update the status of U.S. Application No. 10/286,648. Consequently, Applicants respectfully request that the objection of the disclosure be withdrawn.

II. §112, SECOND PARAGRAPH REJECTION OF CLAIM 41

Claim 41 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner asserts "in claim 41, the 'quality control strip' lacks antecedent basis since independent claim 39 recites a 'check strip'..."

Accordingly, Applicants have amended claim 41 in order for the phrase to have proper antecedent basis. Specifically, in claim 41, Applicants have amended "quality control strip" to "check strip." Consequently, Applicants respectfully request that the rejection of claim 41 under 35 U.S.C. § 112, second paragraph, be withdrawn.

III. §102(b) REJECTION OF CLAIM 39

Claim 39 stands rejected under 35 U.S.C. §102(b) as being anticipated by *Nankai et al.* Applicants respectfully traverse the rejection.

In order to properly anticipate Applicants' claimed invention under 35 U.S.C. §102, each and every element of the claim in issue must be found, "either expressly or inherently described, in a single prior art reference." "The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." See M.P.E.P. § 2131, 8th ed., 2001.

Claim 39 recites, *inter alia*:

"said meter detecting said strip, by detecting a current flow through said auto-on conductor, and responsively entering an active mode"

The Examiner asserts *inter alia*: "the counter and measuring electrodes 34, 35 acts as an auto-on conductor since when the sensor test strip 30 is inserted into a meter 51, a detector circuit 52 detects the insertion of the sensor by detecting current flow through the electrodes" *Office Action*, p. 3, ll. 11-14.

The Examiner cites col. 9, lines 7-12 of *Nankai et al.* to support this proposition. However, Applicants can find no teaching in *Nankai et al.* describing "said meter detecting said strip, by detecting a current flow through said auto-on conductor, and responsively entering an active mode," as recited in claim 39, either in the cited portions thereof (col. 9, lines 7-12), or anywhere else. In *Nankai et al.* when the sensor 30 is inserted into the connector 51 of the main unit of the system, a detector circuit 52 detects the insertion of the sensor and turns on the components throughout the CPU. *Nankai et al.* does not disclose the detector circuit 52 detecting sensor 30 by detecting a current flow through an auto-on conductor. Current flow is measured only after the CPU of the main unit of the system turns on and a sample liquid is supplied to sensor 30. (Emphasis added). *Nankai et al.*, col. 9, ll. 7-26. Accordingly, claim 39 is distinguished from *Nankai et al.*, for at least these reasons, and Applicants respectfully request that the rejection of this claim be withdrawn and the claim allowed.

IV. §103(a) REJECTION OF CLAIMS 39-41

Claims 39-41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *White et al.* in view of *Castellano et al.* Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of the three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims.

Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must "be found in the prior art, and not be based on Applicant's disclosure." See M.P.E.P. §2143, 8th ed., February 2003.

Claim 39 recites, *inter alia*:

"inserting a strip into a meter, said strip including an auto-on conductor"

The Examiner admits that "White et al. fail to teach that the electrodes on the test strip and check strip serve as an auto-on conductor to automatically turn the meter 50 on when either type of strip is inserted therein." *Office Action*, p. 5, ll. 10-12. In an attempt to cure the deficiency, the Examiner alleges *inter alia*: "Castellano et al. teach...when the test strip 204 is inserted into the interface 206, the monitor 202 and the microprocessor 32 therein are automatically activated." *Office Action*, p. 5, ll. 16-17.

The Examiner cites col. 14, lines 41-67 and col. 15, lines 1-32 of *Castellano et al.* to support this proposition. However, Applicants can find no teaching in *Castellano et al.* describing "said strip including an auto-on conductor," as recited in claim 39, either in the cited portions thereof (col. 14, lines 41-67 and col. 15, lines 1-32), or anywhere else. In *Castellano et al.* the interface 206, which is evidently referred to by the *Office Action*, is disposed in the housing of the blood characteristic monitor 202, and not on the test strip 204, and accordingly, can not be considered an auto-on conductor as required by the claims. *Castellano et al.*, col. 14, ll. 41-44 and Fig. 15. Accordingly, claim 39 is distinguished from *White et al.* in view of *Castellano et al.*, for at least these reasons,

and Applicants respectfully request that the rejection of this claim be withdrawn and the claim allowed.

Claims 40 and 41 depend from claim 39. As explained above, claim 39 is distinguished from *White et al.* in view of *Castellano et al.*, whether taken alone or in combination. Accordingly, claims 40 and 41 are also distinguished from *White et al.* in view of *Castellano et al.*, for at least the same reasons as claim 39. Applicants respectfully request that claims 40 and 41 be allowed.

V. CONCLUSION

Applicants respectfully submit that independent claim 39 is in condition for allowance. In addition, claims 40 and 41 are in condition for allowance at least due to their dependence from claim 39.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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